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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/600,359 | 09/21/2001 | Robert Moule | 7376-2 | 2524 |

7590 12/23/2002

Thomas Q Henry
Woodard Emhardt Naughton Moriarty & McNett
Bank One Tower Suite 3700
111 Monument Circle
Indianapolis, IN 46204

EXAMINER

COURSON, TANIA C

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 12/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|------------------------------|------------------|--------------|
| | 09/600,359 | MOULE ET AL. |
| | Examiner | Art Unit |
| | Tania C. Courson | 2859 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 21 September 2001 .

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 17-32 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 17-32 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 21 September 2001 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). ____ .
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6) Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "1" has been used to designate both "marking element" on page 5, line 16, and "label" on page 5, line 27 and reference character "9" has been used to designate both "marking" on page 6, line 5, and "ink" on page 6, line 26. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to because of the following:

- a) Reference numeral "7" fails to show a clear lead line, unable to determine which layer is the "ink 7" layer.
 - b) Applicant needs to be consistent with providing numerals in the figures, specifically Figures 3 and 4.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claim 31 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 30. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim

to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

4. Claims 17-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colley et al. (WO 92/08113) in view of Lim (U.S. Patent No. 5,814,794).

Colley et al. disclose a marking element, comprising:

- a) a first material (Fig. 1, ink layer 3 and page 8, claim 1);
- b) a second absorbent material (Fig. 1, absorbent paper wick 6, and page 8, claim 1);
- c) a heat disruptable barrier layer (Fig. 1 and page 8, claim 1);
- d) the first and second materials being such that when the barrier layer is punctured and the predetermined temperature is exceeded the first material flows in the second material to produce a detectable change (Fig. 1 and page 8, claim 1);
- e) a lower layer (Fig. 1, carrier sheet 2) which together with the heat disruptable layer forms a reservoir (Fig. 1) for the first material and an absorbent layer provided on the opposite side of the barrier layer to said reservoir (Fig. 1);
- f) wherein the absorbent layer is overlaid by a transparent film (Fig. 1, clear layer 9);
- g) wherein the heat disruptable material is a plastics film (Fig. 1, heat shrink film 7);

- h) wherein the inductively heatable element (Fig. 1, temperature condition indicator material 8) is provided on the heat disruptable material (Fig. 1), and;
- i) wherein the inductively heatable element (Fig. 1, temperature condition indicator material 8) is provided by a conductive ink (page 5, lines 14-15).

Colley et al. do not disclose an element capable of being inductively heated by electromagnetic energy, the conductive ink is a metallic ink or a graphic loaded ink, wherein the inductively heatable element is provided by metal, carbon or an electrically conductive plastics or polymeric material, wherein the inductively heatable element is of metal in the form of a film, sheet or foil and a method in which an element is capable of being inductively heated by electromagnetic energy

Regarding claims 1, 27, 28 and 30: Where a product by process claim is rejected over a prior art product that appears to be identical, although produced by a different process, the burden is upon the applicants to come forward with the evidence establishing an unobvious difference between the two. In re Marosi, 218 USPQ 289 (Fed. Cir. 1983).

Regarding claim 24: Colley et al. disclose the conductive ink (page 5, lines 14-15) made of a colored dye material. The particular type of material used to make the conductive ink, absent any criticality, is only considered to be the use of a " preferred " or " optimum " material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant's apparatus, i.e., suitability for the intended

use of Applicant's apparatus. See In re Leshin, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious.

Regarding claim 25: Colley et al. disclose the inductively heatable element (Fig. 1, indicator material 8) made of a temperature condition (column 5, lines 3-13) material. The particular type of material used to make the inductively heatable element, absent any criticality, is only considered to be the use of a " preferred " or " optimum " material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant's apparatus, i.e., suitability for the intended use of Applicant's apparatus. See In re Leshin, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious.

With respect to claim 26: the shape of the inductively heatable element, i.e., film, sheet or foil, absent any criticality, are only considered to be obvious modifications of the shape of the inductively heatable element (Fig. 1, indicator material 8) disclosed by Colley et al. as the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by Applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide using

routine experimentation based on its suitability for the intended use of the invention. See *In re Dailey*, 149 USPQ 47 (CCPA 1976).

With respect to a method in which an element is capable of being inductively heated by electromagnetic energy, Lim teaches a method of heating using a microwave oven that consists of a method in which an element is capable of being inductively heated by electromagnetic energy (Fig. 4a). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the marking element of Colley et al., so as to include a method in which an element is capable of being inductively heated by electromagnetic energy, as taught by Lim, so as to provide a means for heating an element during use of the marking element.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The prior art cited on PTO-892 and not mentioned above disclose a marking element device and method thereof and alternate forms of heating elements;

Colley et al. (U.S. Patent No. 5,597,238)

Ouchi (U.S. Patent No. 5,957,900)

Colley et al. (WO-91/09287)

List (EP-92034 A2)

Beveridge (GB-2373158A)

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tania C. Courson whose telephone number is (703) 305-3031. The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez, can be reached on (703) 308-3875. The fax number for this Organization where this application or proceeding is assigned is (703) 308-7724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



DIEGO F.F. GUTIERREZ
SUPERVISORY PATENT EXAMINER
GROUP ART UNIT 2859

TCC
December 17, 2002